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EXAMINER

CHU, KIM KWOK

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2627

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Supplemental Examiner's Answer

1. This Supplemental Examiner's answer addresses the "REMAND TO EXAMINER" mailed on 08/01/2003 which remands to the examiner for a determination of whether the rejection under 35 U.S.C. § 251 remains appropriate in view of *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). This Supplemental Examiner's answer also takes into account subsequent decisions of the Court of Appeals for the Federal Circuit. The following action is taken:

(a) Regarding Claims 20-23, the recapture rejection of these claims on appeal are withdrawn.

(b) Regarding Claims 11-19, the recapture rejection of these claims on appeal are maintained, and the ground of rejection is follow:

The following ground(s) of rejection are applicable to the appealed claims:

Claims 11-19 are rejected under 35 U.S.C. 251 as being an improper recapture of canceled claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *In re Shahram Mostafazadeh et al*, ___ F.3d ___, ___ USPQ2d ___, 2011 WL 1642830 (Fed. Cir. 2011), *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005), *Pannu v. Storz*

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Instruments Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

In the original application 08/126,515 (the present application is for reissue of U.S. Patent 5,448,552, which issued from application number 08/126,515), Applicant filed amendment dated December 27, 1994, to overcome the Examiner's 103 rejection. In the amendment, Applicant/patentee added the following new features (in bold) to independent claims 1, 3 and 8. Some of which are not present in pending claims 11-19 (underlined). Regarding amended claim 1:

(a) "a plurality of information pits **recorded on said plurality of recording tracks as magnetization directions at said recording surface in a magneto-optical recording operation**";

(b) "information pits **are arranged with such a high pit density as to be non-reproducible by a normal resolution reproduction by use of the light spot but reproducible by a super resolution reproduction by use of the light spot**";

(c) "an address pit **having a convex or concave shape on the recording surface and being arranged with such a low pit**

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density as to be reproducible by a normal resolution reproduction by use of the light spot"; and

(d) "optical disk, to be reproduced by forming a light spot with a predetermined diameter".

Applicant in the amendment of 12/27/94, on page 7, lines 6-8, argued that neither "the claimed information pit nor address pit of claim 1 is disclosed or suggested by the cited art".

Previous to this statement, applicant defined what was meant by "information pit" and "address pit" on page 6, line 17- page 7, line 5 - "The examiner will further note that amended claim 1 calls for a plurality of information pits **recorded on a plurality of recording tracks as magnetization direction at the recording surface in a magneto-optical recording operation. The information pits are arranged with such a high pit density as to be nonreproducible by a normal resolution reproduction by use of a light spot with a predetermined diameter but reproducible by a super resolution reproduction by use of a light spot the predetermined diameter.**

The address pit for address reproduction is formed in advance for the recording operation on the recording surface with respect to one set of recording tracks adjacent to each other in a radial direction of the optical disk. The address pit has a **convex or concave shape on the recording surface and**

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is arranged with such a low pit density as to be reproducible by a normal resolution reproduction by use of the light spot of the predetermined diameter."

The references to added features are again in bold. The references to features not present in pending claims 11-19 are underlined.

In response to the amendment, the parent application was allowed. On the record, the newly submitted claims 11-19 in this reissue application lacks the aforementioned underlined features that were specifically argued as to patentability over Prior Art. In other words, the claims 11-19 are broader than original claims in manner directly pertinent to subject matter surrendered during prosecution. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. Applicant's attention is directed to MPEP 1412.02 and 1412.03.

2. Regarding independent claims 11 and 14 in the reissue application:

Claims 11 and 14 are broadened with respect to original patent claims 1 and 3 by omitting "magnetization directions" and

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changing "magneto-optical recording operation" to "optical recording operation" with respect to the "plurality of information pits" limitation. Also, the details of what constitutes high pit density and low pit density are omitted in claims 11 and 14.

The magnetization aspect: With regard to the magnetization aspect, originally filed claims 1 and 3 were amended to include "as magnetization direction" and to change "recording operation" in claim 1, line 8 and claim 3, line 9 to "**magneto-optical recording operation**" (*emphasis added*). The applicant also specifically indicates that amended claims 1 and 3 "calls for a plurality of information pits recorded on a plurality of recording tracks **as magnetization direction** at the recording surface in a magneto-optical recording operation" (*emphasis added*). (See Paper No. 5, page 6, lines 17-20 and page 7, lines 9-12.) Since the magnetization aspect of the plurality of information pits was added to the respective originally filed claims and relied upon by the applicant to define claims 1 and 3 over the prior art (see page 7, lines 6-8 and 26-28), the magnetization aspect in the "plurality of information pits" limitation of the respective claims relates to surrendered subject matter. Therefore, the omission of the magnetization

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aspect in claims 11 and 14 results in impermissible recapture of previously surrendered subject matter.

The information pits aspect: The high and low pit density limitations were also added to originally filed claims 1 and 3 to define the respective claims over prior art. In the remarks of Paper No. 5, the applicant pointed out that "the information pits are arranged with such a high pit density" (see page 6, lines 20-21 and page 7, lines 12-13) and "the address pit is arranged with " such a low pit density" (see page 7, lines 2-3 and 21-23). Applicant relied on these limitations to define the respective claims over prior art. (See Paper No. 5, page 7, lines 6-8 and 26-28). Although these limitations were broadened with respect to the original patent claims, both claims 11 and 14 still recite two pit densities with a particular relationship to one another, i.e. one pit density is lower than the other. Since claims 11 and 14 retain a broadened form of the high and low pit densities that were added to overcome the art rejection of claims 1 and 3 during original prosecution, there is no recapture with respect to the high and low pit density limitations. See *Ex parte Eggert, supra*.

Recapture is not avoided for claims 11-19: Although the broadening of the high and low pit density limitations is not an impermissible recapture, the rejection of reissue application

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claims 11-19 under 35 USC 251 is proper since the omission of the magnetization aspect in claims 11 and 14 results in impermissible recapture. The retained high and low pit density limitations are unrelated to the surrendered subject matter - the magnetization aspect in claims 11 and 14, and thus, such retention is insufficient to avoid recapture as to the magnetization aspect. See *In re Shahram Mostafazadeh and Joseph O. Smith*, F.3d, USPQ2d 2011 WL 1642830 (Fed. Cir. 2011), where the Federal Circuit stated "Second, the applicants argue that the reissue claims 'each have a number of limitations that are narrowing relative to the surrendered [subject matter].' Br. of Appellants at 29. Specifically, the applicants rely on limitations related to the bus bar, which require that: (1) the 'bottom surfaces of the die attach platform, the contacts and the bus bar [be] substantially co-planar,' (2) the 'protective casing cover[] the die and lead frame while leaving bottom surfaces of the die attach platform, the bus bar and the conductive contacts exposed,' and (3) the protective casing 'physically isolate the bus bar from at least some of the conductive contacts.' J.A. 204. While these limitations certainly narrow the reissue claims relative to the original claims, the narrowing is related only to the bus bar, not the circular attachment pad. In other words, the narrowing

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limitations are unrelated to the surrendered subject matter and thus insufficient to avoid recapture." In the present instance, applicant surrendered the right to have a claim omitting the magnetization aspect, and the presence of the unrelated pit limitations that are narrower than the surrendered claim does not avoid recapture. In the instant reissue application, claims 11 - 19 do not include the magnetization aspect. However, in the original patent prosecution, to overcome the prior art rejection against the claims, the applicants rewrote the claims to include the magnetization aspect, and explicitly relied on the same to define patentability over the art. The applicant made the choice of inserting this limitation into the original independent claims 1 and 3, in a rewritten form. The applicant chose not to prosecute further variations of the original independent claims 1 and 3 omitting the magnetization aspect. At the present, on reissue, applicant is not permitted to completely delete, i.e., omit, all of the magnetization aspect that was relied upon for patentability. See *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001).

Consideration of *Eggert*: In *Eggert*, the decision in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel

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of the Board) is not applicable to claims 11-19. In *Eggert*, the limitation relied-upon in the original patent prosecution to define over the prior art was not omitted in its entirety in the reissue claims, but rather was broadened. The reissue claims thus remained narrowed, as compared with the surrendered claim subject matter in the area related to (germane to) what was surrendered, and recapture was avoided in *Eggert*. In the present instance, the reissue claims 11-19 are not narrowed at all as compared with the surrendered claim subject matter in an area related to magnetization.

3. Regarding independent claim 20 in the reissue application:

Claim 20 is broadened over original patent claim 8 by omitting "magnetization directions" and changing "magneto-optical recording operation" to "optical recording operation" with respect to the "plurality of information pits" limitation. Also, the details of what constitutes high pit density and low pit density are omitted in claim 20.

Claims 8-10 in the original application contained the first and second driving means limitations relied upon for patentability, and were found patentable even before the magnetization aspect in the "plurality of information pits" limitation and the "high density" and "low density" limitations

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was added to claim 8 during original prosecution. Since the first and second driving means limitations were found patentable even before the magnetization aspect in the "plurality of information pits" limitation and the "high density" and "low density" limitations was added, it cannot be said for claims 20-23 that a "patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant." [MPEP 1412.02, part B.1.(A).]. Therefore, there is no recapture of surrendered claim subject matter, even though the magnetization aspect is absent from claims 20-23, since those claims contain the first and second driving means limitations. That is, the broadening of claims 20-23 as to any or all of the magnetization or pit density limitations in claim 20 is not recapture, and the rejection of claims 20-23 under 35 USC 251 is withdrawn.

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4. Appellant may file another reply brief in compliance with 37 CFR 41.41 within two months of the date of mailing of this supplemental examiner's answer. Extensions of time under 37 CFR 1.136(a) are not applicable to this two month time period. See 37 CFR 41.43(b)-(c).

5. A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

/Kim-Kwok CHU/
Examiner
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571-272-7585

/HOA T NGUYEN/
Supervisory Patent Examiner, Art Unit 2627

/JOHN L LE GUYADER/
Director, Technology Center 2600